

REMARKS

Claims 9 and 16 are canceled without prejudice, and therefore claims 10 to 15 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for allowing claim 11.

Claims 9, 10, and 12 were rejected under 35 USC § 102(b) as anticipated by Von Kaenel et al., *A Voltage Reduction Technique for Battery-Operated Systems*, IEEE Journal of Solid-State Circuits, Oct. 1990, at 1136.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with for the reasons previously explained, to facilitate matters, claims 10 and 16 have been canceled without prejudice, and claims 10, 12 and 13 (claims 14 and 15 depend from claim 13) now depend from allowed claim 11 – since claim 10 has been canceled.

Accordingly, claims 10 and 12 to 15 depend from allowed claim 11, and are therefore allowable for the same reasons.

Claims 13 to 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Von Kaenel et al., *A Voltage Reduction Technique for Battery-Operated Systems*, IEEE Journal of Solid-State Circuits, Oct. 1990, at 1136, in view of Ito et al., citation unknown.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with for the reasons previously explained, to facilitate matters, claim 13 now depend from allowed claim 11 (and claims 14 and 15 depend from claim 13) – since claim 10 has been canceled.

Accordingly, claims 13 to 15 depend from allowed claim 11, and are therefore allowable for the same reasons.

In sum, claims 10 and 12 to 15 are allowable – like allowed claim 11.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of presently pending claims 10 and 12 to 15 are allowable – like allowed claim 11. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated: 9/20/2007

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